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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY S. TEMPLETON

Appeal 2009-012198
Application 09/416,278
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Bradley S. Templeton (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 3-8, 54-57, and 72-98. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).¹

THE INVENTION

This invention is a method “that aid[s] in managing telephone calls and meetings.”

Claims 1, 88, and 97, reproduced below, are illustrative of the subject matter on appeal.

1. A computer-implemented method for the intermediation of real time meetings, comprising:
receiving an indication by a requester system that a requester (R-A) wants to request a realtime meeting M-A with a target T-A;
sending to a decider system (D) a request to conduct a real time meeting M-A;
queuing the request for the meeting M-A by the decider system;
receiving by the decider system (D) an availability

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Oct. 28, 2008) and Reply Brief (“Reply Br.,” filed May 7, 2009), and the Examiner’s Answer (“Answer,” mailed Mar. 13, 2009).

status of T-A;

receiving by the decider system (D) an availability status of R-A, where a possible availability status includes not available;

receiving an indication by the requester system that a requester (R-B) wants to request a realtime meeting M-B with target T-B, the meeting M-B to be disjoint in time with the meeting M-A; and such that one of the parties to M-A (R-A or T-A), known as the 'common party' is also the same as one of the parties to M-B (R-B or T-B) and thus there are three distinct parties, the decider D being associated with the common party;

sending to the decider system (D) a request to conduct a real time meeting M-B;

queuing the request for the meeting M-B by the decider system, such that requests for at least two distinct meetings, disjoint in time are placed in the queue, so that multiple pending real time meetings for the common party are in the queue at the same time;

receiving by the decider system (D) an availability status of target T-B;

receiving by the decider system (D) an availability status of the requester R-B, where a possible availability status includes not available;

initiating, by the decider, one of the two meetings M-A and M-B by connecting the common party and the other party to that meeting when the common party and that other party are mutually available; and

dequeuing the request for a meeting.

88. A method comprising:

transmitting or receiving a first request for a real-time meeting between a requestor and a first target, the requestor and the first target being individuals;
determining that the first target is unavailable, using a computing system;
waiting until the first target changes from being unavailable to being available;
when the first target is available, determining if the requester is available;
if the request is available, then initiating the first real-time meeting; and
if the requester is unavailable, then waiting until a time the requestor becomes available.

97. A method comprising:

transmitting or receiving a first request for a first real-time meeting between a requestor and a first target, the requestor and the first target being individuals;
determining that the first target is unavailable, using a computing system;
waiting until the first target changes from being unavailable to being available;
when the first target is available, determining if the requestor is available; and
if the requestor is unavailable, then waiting until a time the requestor becomes available.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Yacenda	US 5,515,426	May 7, 1996
Gisby	US 6,044,146	Mar. 28, 2000
Vaios	US 6,272,216 B1	Aug. 7, 2001
Vardi	US 6,389,127 B1	May 14, 2002

The following rejections are before us for review:

1. Claim 96 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 88-89, 91, 97, and 98² are rejected under 35 U.S.C. § 102(e) as being anticipated by Gisby.
3. Claims 1, 3-8, 54, 55, 72-79, 81, 82, 84, 85, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gisby and Yacenda.
4. Claims 56, 57, and 80 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gisby, Yacenda, and Vaios.
5. Claims 83, 86, and 90 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gisby, and Vaios.
6. Claims 92-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gisby, Yacenda, and Vardi.

² In the Advisory Action mailed on June 2, 2008, the Examiner entered claims 97 and 98 and rejected these claims “for the same reasons set forth with respect to claims 88 and 89.” Advisory Action 2. Therefore, we will consider the absence of claims 88 and 89 from the rejection under 35 U.S.C. § 102(e) as being anticipated by Gisby a typographical error.

ISSUES

The first issue is whether claim 96 is indefinite under 35 U.S.C. § 112, second paragraph. Specifically, the issue is whether the lack on antecedent basis for the term “the phone” renders claim 96 indefinite.

The second issue is whether claims 88-89, 91, 97, and 98 are directed to non-statutory subject matter under 35 U.S.C. § 101. Specifically, the issue is whether claims 88-89, 91, 97, and 98 are directed to an abstract idea.

The third issue is whether claims 1, 3-8, 54, 55, 72-79, 81, 82, 84, 85, and 87 one of ordinary skill in the art would have been led by Gisby and Yacenda to the method of claim 1. The rejection of claims 56, 57, and 80 under 35 U.S.C. 103(a) as being unpatentable over Gisby, Yacenda, and Vaios; the rejection of claims 83, 86, and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gisby, Yacenda, and Vaios; and the rejection of claims 92-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gisby, Yacenda, and Vardi also turn on this issue.

ANALYSIS

The rejection of claim 96 under 35 U.S.C. § 112, second paragraph

The Appellants and the Examiner dispute whether the lack of antecedent basis for the term “the phone” renders claim 96 indefinite. Reply Br. 2-3 and Answer 3. We agree with the Appellants (Reply Br. 2-3), that the lack of explicit antecedent basis for this term does not render claim 96 indefinite nor does it prevent one of ordinary skill in the art from reasonably ascertaining the scope of the claim. We reverse this rejection of claim 96 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 88-89, 91, 97, and 98 under 35 U.S.C. § 102(e) as being anticipated by Gisby and the rejection of claim 90 under 35 U.S.C. § 103(a) as being unpatentable over Gisby and Yacenda

As discussed below, we find that claims 88-91, 97, and 98 are directed to nonstatutory subject matter and that this finding is dispositive of the patentability of these claims. Accordingly, we do not reach the prior art rejection of claims 88-89, 91, 97, and 98 under § 102(e). *See Diamond v. Diehr*, 450 U.S. 175, 188 (S. Ct. 1981); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach an obviousness rejection on appeal after concluding many claims were non-statutory under § 101); *In re Bilski*, 545 F.3d 943, 951 n.1 (noting that § 101 is a threshold requirement and that the Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter); *Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (per curiam) (expanded panel) (precedential) (as the claims on appeal do not recite patent-eligible subject matter under § 101, the prior art rejections need not be considered).

The rejection of claims 1, 3-8, 54, 55, 72-79, 81, 82, 84, 85, and 87 under 35 U.S.C. § 103(a) as being unpatentable over Gisby and Yacenda

The Appellant and the Examiner dispute whether the Examiner's combination of Gisby and Yacenda disclose the step of "receiving by the decider system (D) an availability status of R-A, where a possible

availability status include not available” recited in claim 1. *See* App. Br. 34-37, Reply Br. 15-18, and Answer 25. Specifically, the Appellant argues that:

simply adding the call back feature of Yacenda would not, by itself, read on the claims at issue unless a still further modification were made such that, in addition to the numerical values (1-10) assigned to the registers of the queue 69, it were also possible to assign a value of “unavailable” to a register.

Reply Br. 15-16.

We agree with the Appellants. “[I]nclude[ing] the call back function of Yacenda et al. in the system of Gisby et al” (Answer 9) would not have resulted in a modification of Gisby’s numerical priority, which the Examiner relies upon to teach the claimed availability status. We note that the Examiner provides not further evidence or reasoning with logical underpinnings to support their conclusion of obviousness. Therefore, we reverse this rejection of claim 1, and claims 3-8, 54, 55, 72-79, 81, 82, 84, 85, and 87, dependent thereon.

The rejection of claims 56, 57, and 80 under 35 U.S.C. § 103(a) as being unpatentable over Gisby, Yacenda, and Vaio; the rejection of claims 83 and 86 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gisby and Vaio; and the rejection of claims 92-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gisby, Yacenda, and Vardi

These rejections are directed to claims directly or indirectly dependent on claim 1, whose rejection we have reversed above. We will not sustain the rejections of claims 56, 57, 80, 83, 86, and 92-96 over the cited prior art. *Cf.*

In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.") We note that the Examiner has not relied upon Vaio or Vardi to cure the deficiency at issue with the rejection of independent claim 1 above.

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection on claims 88-91, 97, and 98.

We find that claims 88-91, 97, and 98 are directed to non-statutory subject matter as they encompass an abstract idea. The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218, No. 08-964, 2010 WL 2555192 (U.S. June 28, 2010). The Court held that the term "process" as used in 35 U.S.C. § 101, does not categorically exclude business methods. *Bilski*, 130 S. Ct. at 3228-3229.

The Court is unaware of any argument that the "ordinary, contemporary, common meaning," *Diehr, supra*, at 182, 101 S.Ct. 1048, of "method" excludes business methods. Nor is it clear what a business method exception would sweep in and whether it would exclude technologies for conducting a business more efficiently. *Bilski*, 130 S. Ct. at 3222.

"At the same time, some business method patents raise special problems in terms of vagueness and suspect validity." *Bilski*, 130 S. Ct. at 3229. (citing *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 397 (2006)) (Kennedy, J., concurring).

In searching for a limiting principle, this Court's precedents on the unpatentability of abstract ideas provide useful tools. See *infra*, at 3229-3231. Indeed, if the Court of Appeals were to succeed in defining a narrower category or class of patent applications that claim to instruct how business should be conducted, and then rule that the category is unpatentable because, for instance, it represents an attempt to patent abstract ideas, this conclusion might well be in accord with controlling precedent.

Bilski, 130 S. Ct. at 3229 (2010).

Claims 88-91, 97, and 98 are drawn to business methods. Taking claim 88 as representative, the broadest reasonable construction of the claimed process in light of the Specification as it would be interpreted by one of ordinary skill in the art is that it provides a series of instructions that do no more than transmit or receive a request for meeting; determine whether a requestor and target is available or not; and initiates a real-time meeting when both the requestor and target is available and if unavailable, waits. The claim encompasses any use of this concept.

We now turn to the question of whether the claimed process subject matter is patent-eligible under 35 U.S.C. § 101. Various factors must be considered and weighed when analyzing claims as a whole before reaching a conclusion on patent subject matter eligibility. The factors relevant in this case are the lack of an express or implied recitation in the claims to a particular machine or transformation and that the claims are a mere statement of a general concept. There are no express or implied recitations to a particular transformation in claim 1. Claim 1 recite “using a computing system” to perform the step of determining that the first target is unavailable.

However, this term suggests at best a nominal use of a machine and imposes no meaningful limits on the scope of the claim.

As we have reasonably broadly construed it, the subject matter of claim 31 is a series of instructions for transmitting or receiving a request for meeting; determining whether a requestor and target is available or not; and initiating a real-time meeting when both the requestor and target is available and if unavailable, waiting. The vague instructions listed in the claim do no more than instruct how business should be conducted. In the words of *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972), the claimed process “would wholly pre-empt the [this concept] and in practical effect would be a patent on the [concept] itself.”

For the foregoing reasons, based upon consideration of all the relevant factors with respect to claims 88-91, 97, and 98 as a whole, claims 188-91, 97, and 98 are held to claim an abstract idea and are therefore rejected as ineligible subject matter under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1, 3-8, 54-57, and 72-98 is reversed. We enter a new ground of rejection on claims 88-91, 97, and 98.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. 41.50(b)

JRG